

REMARKS**I. Introduction**

With the cancellation, without prejudice, of claim 28, claims 1 to 27 are currently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Allowed Claims 8 to 11 and 24

Applicants note with appreciation the indication that claims 8 to 11 and 24 are allowed.

III. Rejection of Claims 1 to 7, 12, 13 and 28 Under 35 U.S.C. § 112

Claims 1 to 7, 12, 13 and 28 were rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. Applicants respectfully submit that the present claims fully comply with the enablement requirement for at least the following reasons.

As an initial matter, claim 28 has been canceled rendering moot the present rejection with respect to claim 28.

As regards the enablement requirement, the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See *id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of

working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See *id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that the examiner's analysis must therefore "consider all the evidence related to each of these factors" so that any nonenablement conclusion "must be based on the evidence as a whole." (See M.P.E.P. § 2164.01). It is respectfully submitted that the Final Office Action has not addressed these factors.

It is believed that the present assertions of the Final Office Action do not meaningfully address — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does. In short, it is believed that the Final Office Action's assertion that the Specification fails to explicitly state that a starting mixture that does not include any thermoplastic material, does not address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims — a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claim.

It is therefore respectfully submitted that the Final Office Action has plainly failed to establish that the claim does not comply with the enablement requirement of 35 U.S.C. § 112. Notwithstanding the foregoing, it is respectfully submitted that the claim fully complies with the requirements of 35 U.S.C. § 112 for the following additional reasons.

Applicants respectfully submit that one skilled in the art would readily understand that the Specification provides for the features recited in claims 1 and canceled claim 28 (the subject matter of which has been included in amended claim 14).

When the claims are read in light of what the Specification expressly describes, especially that which is described, e.g., at page 1, lines 6 to 10, page 2, line 31 to page 3, line 6, and page 5, line 4 to page 8, line 29 of the Specification, Applicants submit that one skilled in the art would be able to reasonably discern that the starting mixture of claims 1 and amended claim 14 may be provided without any thermoplastic material. The Background section of the Specification describes conventional methods used for manufacturing magnet cores, and describes that an important feature according to conventional methods is the use of thermoplastic material. In the Summary section of the Specification, it is explained that a method according to the present application is an improvement over conventional methods, in particular because of the different materials

used. The Detailed Description section of the Specification describes the method steps according to the present application and materials used when practicing the methods. Not once is use of a thermoplastic material suggested for practicing the methods hereof. This is in stark contrast to that which is stated in regards to the discussion of conventional methods, regarding which it is stated that “[i]ron powders mixed with a thermoplastic resin *are particularly suitable* for manufacturing magnet cores.” *Specification*, page 1, lines 6 to 7. Since the Specification indicates the particular suitability of using thermoplastic material according to conventional methods, indicates that an advantage of the methods according to the present application relates to differences in materials used, and makes absolutely no mention whatsoever of the use of a thermoplastic material (described as *particularly suitable* when describing conventional methods), it is respectfully submitted that the Specification clearly indicates providing, in a method according to the present application, a starting mixture having no thermoplastic material. It is therefore respectfully submitted that the Specification enables one skilled in the pertinent art to practice the claimed subject matter of the present claims without undue experimentation.

Furthermore, it is noted that the Specification describes example manners to practice precisely the claimed method for manufacturing a pressed part from a soft magnetic composite material, e.g., including providing a starting mixture including an iron powder and an auxiliary pressing agent, and not including a thermoplastic material. The examples discussed in the Specification do not refer to providing a starting mixture including a thermoplastic material, and one skilled in the art would be able to practice the claimed subject matter, e.g., by performing that which is described with respect to the examples provided in the Specification. For this additional reason, it is respectfully submitted that the Specification enables one skilled in the pertinent art to practice the claimed subject matter of the present claims.

In view of all of the foregoing, it is respectfully submitted that the claims fully comply with the enablement requirement of 35 U.S.C. § 112. Withdrawal of the rejection is therefore respectfully requested.

IV. Rejection of Claims 14 to 23, 26, and 27 Under 35 U.S.C. § 103(a)

Claims 14 to 23, 26, and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,268,140 (“Rutz et al.”) and U.S. Patent No. 5,047,391 (“Bock et al.”). It is respectfully submitted that the combination of

Rutz et al. and Bock et al. does not render unpatentable the present claims for at least the following reasons.

Claim 14 recites postforming a pressed part. As set forth in the Amendment filed on February 25, 2005, while Bock et al. may refer to grinding, nowhere do Bock et al. disclose or suggest that the performed grinding postforms a part. Nowhere do Bock et al. disclose or suggest postforming an annealed part. In the "Response to Arguments" section of the Final Office Action, it is asserted that "applicant himself includes grinding as a postforming method." As indicated in the Amendment filed on February 25, 2005, while grinding may postform a part, it does not necessarily do so. Accordingly, reference in Bock et al. to grinding does not disclose or suggest postforming a pressed part. It is therefore respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claim 14.

Furthermore, claim 14 has been amended herein without prejudice to include the features of canceled claim 28. Since the combination of Rutz et al. and Bock et al. does not disclose or suggest the features of "providing a starting mixture including an iron powder and an auxiliary pressing agent . . . wherein the starting mixture does not include a thermoplastic material," it is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claim 14.

Claims 15 to 23, 26, and 27 ultimately depend from claim 14 and therefore include all of the features recited in claim 14. Accordingly, without passing judgment on the merits of the Final Office Action's assertions regarding the limitations of claims 15 to 23, 26, and 27, it is respectfully submitted that the combination of Rutz et al. and Bock et al. does not render unpatentable claims 15 to 23, 26, and 27, by virtue of these claims' dependence on claim 14. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

V. Rejection of Claim 25 Under 35 U.S.C. § 103(a)

Claim 25 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Rutz et al., Bock et al., and U.S. Patent No. 6,383,281 ("Bayer"). It is respectfully submitted that the combination of Rutz et al., Bock et al., and Bayer does not render unpatentable claim 25 for the following reasons.

Claim 25 depends from claim 14 and therefore includes all of the features of claim 14. Accordingly, without passing judgment on the merits of the Final Office Action's assertions regarding the features of claim 25, it is respectfully submitted that the combination

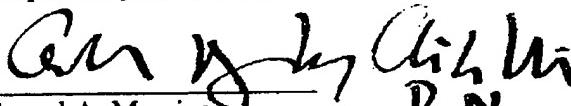
of Rutz et al., Bock et al., and Bayer does not render unpatentable claim 25, by virtue of this claim's dependence on claim 14. *Id.*

VI. Conclusion

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: September 19, 2005

By: 
Gerard A. Messina
Reg. No. 35,952
KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO 26646

*R.N.
42,194
(Clifford
A. Ulrich)*